

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application for
Reissue of: U.S. Patent No. 5,662,584
Original Serial No.: 08/545,927
Original Filing Date: October 20, 1995
Applicants: Koichiro Hori et al.
For: ENDOSCOPE WITH POSITION DISPLAY FOR
ZOOM LENS UNIT AND IMAGING DEVICE
Original Examiner: J. Leubecker (Group 3302)
Reissue Docket No.: OKTA-6 RE

Box 7
Assistant Commissioner for Patents
Washington, D.C. 20231

REISSUE APPLICATION DECLARATION

And

POWER OF ATTORNEY BY INVENTORS

As the below-named inventors and applicants, we hereby declare that:

1. Our residence, post office address and citizenship are as stated below next to our names.
2. We believe that we are the original, first and joint inventors of the subject matter which is described and claimed in U.S. Patent No. 5,662,584, granted on September 2, 1997, for which invention we solicit a reissue patent pursuant to the provisions of 35 USC 251.

3. The above-identified U.S. Patent No. 5,662,584 issued on U.S. Application Serial No. 08/545,927, filed October 20, 1995, as a continuation-in-part of parent Application Serial No. 08/319,886, filed October 7, 1994, which issued as U.S. Patent No. 5,582,576, on December 10, 1996.

4. The above-identified U.S. Patent No. 5,662,584 is owned solely and exclusively by Vista Medical Technologies, Inc. by virtue of an assignment executed by us that was recorded in the United States Patent and Trademark Office, on October 1 1996, at Reel 8159, Frame 0005.

5. A reissue application is attached hereto and this declaration is an integral part thereof. Said reissue application indicates the matter to be deleted by reissue as being enclosed in brackets and the matter to be added by reissue as being underlined.

6. As required in 37 CFR 1.171, an order for a title report, accompanied by a request to charge the required fee to the Deposit Account of the attorney of record, as set forth in 37 CFR 1.19(b)(6), is filed herewith.

7. Also filed herewith is a document comprising an offer to surrender the Patent for which reissue is sought by the assignee of the entire interest of the Patent., as required in 37 CFR 1.172 and 1.178.

8. The assent of the assignee to this reissue application is set forth below.

9. We acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 CFR 1.56(a). In compliance with this duty, an information disclosure statement is filed herewith.

10. We hereby state that we have reviewed and understand the contents of the above-identified reissue application attached hereto, including its specification and claims, and the accompanying affidavit of Nicholas A. Pandiscio.

11. Prior to signing the declaration in said U.S. Patent Application Serial No. 08/545,927, which matured into the above-identified patent, we reviewed, believed we understood, and approved, the claims in the application. At the time we signed said declaration in Application Ser. No. 08/545,927 we did not observe that the claims contained any errors.

12. We now understand and believe that said U.S. Patent No. 5,662,584 is partly invalid and inoperative by reason of claims 1, 7 and 9 of the disclosure containing errors which arose without deceptive intent.

13. On information and belief, the fact that the claims of the patent contain errors affecting the validity and operability of those claims and the patent was first discovered by our patent counsel, Nicholas A. Pandiscio, as explained in his affidavit which forms part of our application for reissue of said U.S. Patent No. 5,662,584. We have read his affidavit and incorporate it by reference as part of our reissue application.

14. The errors which are the basis of this reissue application, and which render our U.S. Patent No. 5,662,584 partly invalid and inoperative, are as set forth in the following sub-paragraphs A-C:

A. Claim 1, at column 16, line 21 (in the application, at page 27, lines 4-5), recites a tube "being mounted within said outer tube". That recitation is erroneous in that the claim contains no antecedent for "said outer tube". We believe that it was not necessary that claim 1 and its dependent claims 2-6 be restricted to an endoscope having two tubes, one inside of the other, since the novelty of our invention was not in the structure of the tube assembly but rather the electronic system for causing the display means to generate a video image representative of the position of at least the zoom lens or the CCD imaging device.

B. Claim 7, at column 18, lines 1-3 (in the application, at page 30, lines 7,8) recites "means attached to said handle assembly for connecting said proximal end of said light transmitting means to a light source". That recitation is erroneous in that there is no antecedent for "said light transmitting means". In this connection it should be noted that claim 7, in the patent, at column 17, lines 65-68 (in the application, page 30, lines 5-6) recites "a space between said outer and inner tubes for transmitting light to illuminate an object viewed by said objective lens unit," but does not positively recite any "light transmitting means" to which

the light source mentioned in the claim at column 18, lines 1-3 (in the application at page 30, lines 7-8) is connected.

C. Claim 9, at column 18, lines 16-18 (in the application at page 30, lines 18-20) recites "said light transmitting means". That recitation is in error as a redundancy since claim 9 depends from claim 7 and claim 7 already makes mention (column 18, line 2) of "said light transmitting means".

15. On information and belief, the changes we propose to make to the claims to correct the foregoing errors do not introduce any new matter, have an adequate basis in the specification of the application, and do not enlarge the scope of the claims.

Although we propose to delete certain language from claim 9 pertaining to the light transmitting means, it will not affect the scope of that claim since we propose to insert substantially the same language in its parent claim 7. Furthermore addition of that language to claim 7 will have the effect of limiting rather than broadening that claim.

16. The foregoing errors in claims 1,7 and 9 all arose without any deceptive intent on our part and, on information and belief, without any deceptive intent on the part of our attorneys.

17. By this reissue application we also propose to (a) amend claim 7 by addition of the word "electronic" in column 18, line 9, and (b) amend claim 12 by addition of "output" in column 18, line 33. These amendments are not based on any errors that affect the validity or operability of those claims, but rather are presented merely for the purpose of eliminating any possibility of argument as to the antecedents or meaning. These particular amendments to claims 7 and 12 do not introduce any new matter, do not broaden the scope of the claims and do not raise any new issues.

18. We acknowledge that the Assignee retains the right to prosecute the reissue application of which this declaration is a part, and to receive any reissue patent granted on said application.

19. We appoint Nicholas A. Pandiscio, Registration No. 17,293; Mark J. Pandiscio, Registration No. 30,883; and Scott R. Foster, Registration No. 20,570; or any of them, all of the firm of Pandiscio & Pandiscio, 470 Totten Pond Road, Waltham,

Massachusetts 02154, (Telephone No. 781-290-0060), as our attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith.

20. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the reissue application or any patent issued thereon.

Date: Dec 20, 1999

Koichiro Hori

Koichiro Hori

Residence: 24 Parker Road, Framingham, MA 01701

P.O. Address: same

Citizenship: Japan

Date: Dec 28, 1999

Herb A. Thaler

Herb A. Thaler

Residence: 680 Pleasant Street, Framingham, MA 01701

P.O. Address: same

Citizenship: U.S.A.

Assent of Assignee To Reissue Application

I, Koichiro Hori, declare that I am a Vice-President of the Assignee, Vista Medical Technologies, Inc., and that I am authorized to act on the Assignee's behalf in connection with the attached application for reissue of said U.S. Patent No. 5,662,584. I further declare that Assignee assents to the attached application for reissue. I further declare that the foregoing statements relating to the Assignee are true and were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1 001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the reissue application or any patent that may issue thereon.

Signature:

Koichiro Hori

Name:

Koichiro Hori

Title:

Vice President

Assignee:

Vista Medical Technologies, Inc.

Date:

Dec. 20, 1999

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12/10/99

OKTA-6 RE

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Reissue of: U.S. Patent No. 5,662,584

Original Ser. No.: 08/545,927

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Applicants: Koichiro Hori et al.

For: ENDOSCOPE WITH POSITION DISPLAY FOR
ZOOM LENS UNIT AND IMAGING DEVICE

Original Examiner: J. Leubecker (Group 3302)

Reissue Docket No.: OKTA-6 RE

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OFFER TO SURRENDER PATENT AND ASSENT BY ASSIGNEE
(Pursuant to 35 USC 251 and PTO Rule 1.178)

We, Koichiro Hori and Herbert A. Thaler, Applicants of the accompanying application for reissue of the above-identified U.S. Letters Patent, of which Vista Medical Technologies, Inc. is now sole owner by written and recorded assignment from us, and on whose behalf and with whose assent the accompanying application for reissue is made, hereby offer to surrender said Letters Patent.

Date: Dec 20, 1999

Koichiro Hori
Koichiro Hori

Date: Dec 28, 1999

Herbert A. Thaler
Herbert A. Thaler

OKTA-6 RE

The undersigned, assignee of the entire right, title and interest in the above-identified Letters patent, hereby assents to the surrender of said Letters Patent and the accompanying reissue application.

Vista Medical Technologies, Inc.

Date: Dec. 20, 1999

By: Koichiro Hori
Koichiro Hori
Vice-President

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For: ENDOSCOPE WITH POSITION DISPLAY FOR
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Original Examiner: J. Leubecker (Group 3302)

Reissue Docket No.: OKTA-6 RE

3 January, 2000

Box 7

Assistant Commissioner for Patents

Washington, D.C. 20231

ORDER FOR TITLE REPORT

Pursuant to 37 CFR Section 1.171, an order for a title report on the above identified U.S. Patent is hereby made, to be placed in the file of the application for reissue thereof filed herewith.

Vista Medical Technologies, Inc. ("Assignee) owns 100% interest in the above-identified patent by virtue of an assignment executed on September 23, 1996 and recorded in the United States Patent and Trademark Office, on October 1, 1996, at Reel 8159, Frame 0005. Therefore, Assignee retains the right to execute submit this Order For Title Report and to file and prosecute the related reissue application submitted herewith.

OKTA-6 RE

The enclosed check in the amount of **\$ 370.00** is believed to cover the PTO fee for the title report, as required under 37 CFR 1.19(b)(4), as well as the official filing fee for the reissue application. Please charge any additional fees or credit any overpayment to Deposit Account No. 16-0221.

A copy of this order is attached for obtaining verification of such charge or credit.

Respectfully submitted,

 3 January 2000

Nicholas A. Pandiscio Reg. No. 17,293
Pandiscio & Pandiscio
470 Totten Pond Road
Waltham, MA 02451
Tel. No. (781)290-0060
Attorney For Applicants

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AFFIDAVIT OF NICHOLAS A. PANDISCIO

I, Nicholas A. Pandiscio, being over 21 years of age and competent to testify, declare as follows:

1. I drafted and prosecuted U. S. Patent Application Serial No. 08/545,927, which matured into U.S. Patent No. 5,662,584 for which reissue is being sought.
2. I also filed PCT European Application No. 96936409.0-2305 which was based on and claimed the benefit of the filing date of said U.S. Application Serial No. 08/545,927.
3. Prior to the signing the declaration in U.S. Patent Application Serial No. 08/545,927, the inventors and co-applicants, Koichiro Hori and Herbert A. Thaler, reviewed and approved the claims of that application. Moreover, at the time that the application was filed, neither they nor I observed that the claims contained any errors.
4. U.S. Patent Application Serial No. 08/545,927 was allowed in the first Official Action, with the only changes to the claims consisting of amending claims

1-6 for clarity by changing "means" to "electronic means" pursuant to an Examiner's amendment dated November 18, 1996 which was agreed to by me as patent counsel for applicants. At the time that the Examiner and I discussed amending claims 1-6, I did not realize that claim 1 contained an error affecting its validity and operability. On information and belief, the Examiner also did not realize that claim 1 was defective, since he did not suggest amending claim 1 beyond the simple change noted above.

5. Subsequently in the course of preparing instructions to a European patent agent as to how to respond to a European Patent Office communication in said European Application No. 96936409.0-2305, I reviewed the claims in the above-identified Patent for which reissue is now sought. My review of the claims of the Patent for which reissue is now sought revealed that certain claims contained errors as set forth in paragraph 7 hereof.

6. Having discovered the foregoing errors, I recommended to Mr. Koichiro Hori, one of the applicants and also Vice-President of the Assignee, Vista Medical Technologies, that I be authorized to prepare and file an application for a reissue of said Patent seeking to correct those errors. He agreed. The nature of the errors were communicated to the other applicant, Herbert A. Thaler, by way of submitting to him for review and signature the application for reissue of which this affidavit is a part.

7. Claims 1, 7, and 9 of U.S. Patent No. 5,662,584 contain the following errors:

A. Claim 1, at column 16, line 21 (in the application, at page 27, lines 4-5), inadvertently and erroneously recites a tube "being mounted within said outer tube." That recitation is erroneous in that there is no antecedent for "said outer tube".

B. Claim 7, at column 18, lines 1-3 (in the application, at page 30, lines 7, 8) recites "means attached to said handle assembly for connecting said proximal end of said light transmitting means to a

light source". That recitation is erroneous in that there is no antecedent for "said light transmitting means".

C. Claim 9, at column 18, lines 16-18 (in the application, at page 30, lines 18-20) erroneously recites "light transmitting means". That recitation is in error as a redundancy since claim 9 depends from claim 7 and claim 7 already makes mention (column 18, line 2) of (but does not positively recite) "light transmitting means".

8. In the reissue patent application of which this affidavit is a part, Applicants propose to correct the errors in claims 1, 7 and 9 by making the following changes, which changes I believe render the claims more definite:

A. Claim 1, column 16, line 21, delete "being mounted within said outer tube".

B. Claim 7, column 17, line 65, insert a semicolon after "inner tubes", and after the semicolon insert a new line with the words "light transmitting means in said space", with the latter forming a continuous clause with the remaining language in lines 65-67.

C. Claim 9, column 1, line 16-18, delete the language "further including light transmitting means disposed in said space between said inner and outer tubes; also in line 18, insert "wherein" before "said light transmitting means" and replace "having" to "has".

9. The following description of the background of the invention helps to explain the need for correction of the above-noted errors. The invention pertains to an electronic endoscope. The endoscope, in its most basic form, includes a tube with an optical element mounted within the tube at its distal end and an imaging device within the tube spaced from the optical element, with the space between the optical element and the imaging device constituting an optical channel along which images are transmitted by the optical element and focused onto the imaging device. The imaging device converts the image into an electronic signal that is processed into an image viewable with, for example, a

monitor. The optical channel is free of any obstructions between the optical element and the imaging device that would prevent a complete and undistorted image. An endoscope is used for viewing places that are unlighted or have very low illumination. Therefore, endoscopes typically include means for transmitting light from a light source to the region being viewed by the optical element. To respect the "no obstructions" parameter, the light transmitting means typically is mounted outside of the perimeter of the optical channel. Accordingly a common approach is to provide the endoscope with a second tube that surrounds and is spaced from the tube that carries the optical element and the imaging device, and to transmit the light through the space between the two tubes onto the area to be viewed with the endoscope, typically by means of optical fibers.

10. In claim 1 the mention of an "outer tube" constitutes an error and should be eliminated as proposed by Applicant's reissue application because an outer tube is not a necessary part of the invention. I believe that claim 1 need not specifically recite two tubes, since the point of novelty of the invention being claimed is not in the structure of the tube assembly but rather the electronic system for causing the display means to generate a video image representative of the position of at least the zoom lens or the CCD imaging device. Also the idea of specifically claiming an endoscope apparatus having two tubes one inside of the other was already addressed by independent claim 7, which is almost exactly like claim 1 except for the fact that it specifically recites an outer tube and an inner tube, with a space between the two tubes.

11. With respect to claim 7, it recites, in the patent at column 17, lines 65-68 (in the application at page 30, lines 5-6), a space between said outer and inner tubes for transmitting light to illuminate an object viewed by said objective lens unit". However, it does not positively recite any "light transmitting means" to which the light source mentioned in the claim at column 18, lines 1-3 (in the application at page 30, lines 7-8) is connected. The proposed insertion in column 17, of a new clause claiming a light transmitting means is proper and

necessary to provide a proper antecedent for the light transmitting means that is mentioned later in that claim at column 18, line 2.

12. As for claim 9, deletion of the light-transmitting means from that claim is necessary if claim 7 is amended as proposed by the reissue application.

13. The proposed changes to 1, 7 and 9 do not introduce any new matter, have an adequate basis in the specification, and do not enlarge the claims. Further these changes would have been made during the prosecution of the application is the need for same had been discovered at that time.

14. In the reissue application of which this declaration forms a part, it is proposed also to (a) amend claim 7 by addition of the word "electronic" in column 18, line 9, and (b) amend claim 12, by addition of "output" before "signals" in column 18, line 33. These amendments are not based on any errors that affect the validity or operability of those claims, but rather are presented merely for the purpose of eliminating any question as to antecedents or meaning. These particular amendments to claims 7 and 12 do not introduce any new matter, do not broaden the scope of the claims and do not raise any new issues.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or of any patent issued thereon.

Date: 12/10/99


Nicholas A. Pandiscio

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